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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,055	08/30/2001	David N. Klein	08935-139002	9594
26161	7590	03/12/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			RUTHKOSKY, MARK	
		ART UNIT	PAPER NUMBER	
		1745		

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/943,055	KLEIN
Examiner	Art Unit	
	Mark Ruthkosky	1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 January 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-27 is/are pending in the application.
4a) Of the above claim(s) 1-18 is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 19-27 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

Priority

The application is a continuation of application 09/293,168, now U.S. Patent 6,291,096, filed 4/16/1999.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, drawn to a battery tester and battery comprising the tester, classified in class 429, subclass 93.
- II. Claims 19-27, drawn to a battery indicator, classified in class 429, subclass 92.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as indicating a state of the battery without being part of the tester. The battery tester is used to test the charge of a battery. The indicator may be a part of a battery tester, however it has a separate utility. See MPEP § 806.05(d).

If inventions I and II are considered to be related as a combination and a subcombination, the inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In

the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require a display printed on a substrate displaying a first optical state. The subcombination has separate utility such as an indicator.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. During a telephone conversation with Mr. Denis Maloney on 4/3/2003 a provisional election was made with traverse to prosecute the invention of Group II, claims 19-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

The amendment filed 8/31/2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows:

The claims have been reviewed and support for the newly added claims 19-20 is found on pages 3-5 of the instant specification. However, claims 21-27 include the limitations that the electrophoretic display comprises “an encapsulated display media.” Claim 22 claims a capsule including at least one electrophoretic particle and a dye. Claims 23-24 also include elements of the capsule. These limitations are not supported by the instant specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereto by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 19-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Albert (6,118,426).

Claims 12-18 of Albert are identical to the claims of the instant application. Albert (6,118,426) teaches a battery indicator comprising an electrophoretic display, a non-linear element (which may be a diode), and a voltage divider. The indicator is coupled to the electrodes of a battery and may be printed on the substrate. The voltage divider may include two, high-impedance resistors. The voltage at the terminal of the display is a fraction of the battery voltage. (See claims 11-20, Figs. 1-3 and col. 8.) Although a battery is not claimed, it is noted throughout the reference patent, for example col. 8. Thus, the claims are anticipated.

Claims 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sterling (US 1,497,388.)

Sterling (US 1,497,388) teaches a battery indicator with an electrically addressable display printed on a substrate in electrical communication with a battery. The display shows a

first optical state in response to the voltage of the battery. As the battery is discharged, the display shows a comparatively different optical display when the battery falls below a predetermined threshold as indicated on the display (see figures 1-4, col. 2-3 and the claims.) The carrier substrate is impregnated with an indicator, which is considered to be printing as the material is printed by absorption onto the substrate.

Claims 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailey (US 5,654,640.)

Bailey (US 5,654,640) teaches a battery indicator with an electrically addressable display printed on a substrate in electrical communication with a battery. The display shows a first optical state in response to the voltage of the battery. As the battery is discharged, the display shows a comparatively different optical display when the battery falls below a predetermined threshold as indicated on the display (see claims 1-20.) Voltage dividers are taught in col. 10, lines 35-65.) With regard to claim 21, the reference does not teach a nonlinear electrical element or a resistor in a circuit as described.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited art does not read upon the instant claims, however, the references include general teachings and relevant features as to the state of the art at the time of the invention.

Ishimoto (US 5,256,500) teaches a battery indicator with an electrically addressable display on a substrate in electrical communication with a battery. The display shows a first optical state in response to the voltage of the battery. As the battery is discharged, the display

shows a comparatively different optical display when the battery falls below a predetermined threshold as indicated on the display (see figures 1-4, col. 2-3 and the claims.) The display is not printed on the battery or a substrate.

Kacprowicz et al. (US 6,232,782) does not qualify as prior art.

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Ruthkosky whose telephone number is 571-272-1291. The examiner can normally be reached on FLEX schedule (generally, Monday-Thursday from 9:00-6:30.) If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached at 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free.)

Mark Ruthkosky

Primary Patent Examiner

Art Unit 1745

Mark Ruthkosky
3/4/04